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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,810	01/29/2002	Mark D. Hanes	MRZ 9038.1	6785

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SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

RATHINASAMY, PALANI P

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/12/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/12/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

Office Action Summary

Application No.

10/059,810

Applicant(s)

HANES, MARK D.

Examiner

Palani P. Rathinasamy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-10,12-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-10,12-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.
2. This action is in response to Amendment filed 2/20/2007.
3. Claims 4, 6, 11, and 18 have been cancelled. Claim 1, 7, 8, 12, 16, and 19 have been amended. Claims 1-3, 5, 7-10, 12-17, and 19-20 are pending.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, 7-10, 12-17, and 19-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/059,810. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because they claim common subject matter as follows: (1) online motivation website, (2) customer selects from a plurality of awards and documents, (3) program to create the motivational package, (4) program to print the package; (5) customizable, (6) history database, etc.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Regarding claim 9 and 12 (including their dependent claims), the use of "and/or" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. It is not clear whether the Applicant meant to refer to "and" or "or" since it cannot be both (See MPEP § 2173.05(d)). The Examiner assumes the applicant meant to refer to "or".

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1, 2, 8, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Karas et al. (US 2002/0103711 A1).**

8. Regarding claims 1, and 16, Karas et al. teaches an online method for which a sender (customer) can select a message (document) to be sent and an amount (award) to be sent to a recipient (participant). (Abstract). The sender chooses their own message to be sent or selects from prewritten messages. (Fig 2). The message is customizable by the sender and can be changed based on the occasion. (Fig. 3A; Fig. 9). The sender selects from various amounts to be sent to the recipient. (Fig. 2; [0039]). Optionally, the payment can be made to a specific merchant or store (ie. gift certificate), instead of to the recipient. ([0030]. Figure 2 is an example of the website (first program) to which the sender accesses and selects a custom message and amount that is to be transmitted to the recipient. (Fig. 1; Fig. 2; [0037]-[0039]). Figure 1 shows a printing system (second program) that renders the electronic version of the motivation package into an off-line format. (Fig. 1; Fig. 12; [0057]). The sender previews the message and amount on screen before it is sent out. ([0053])

According to applicant's specification (US 2002/0120511 A1) a motivation document is a document that "recognizes the participant." (Applicant Specification, [0034]). Examiner takes the birthday "gram" that is given as an example in Figure 4A to be a "motivational document" in that it recognizes a recipient of their birthday (achieving a certain age). As another example, Kraus et al. teaches that this could be used to recognize a recipients "graduation". ([0038]).

9. Regarding claim 2, Karas et al. teaches that the message and award are customized online by the sender. (Abstract; Fig. 2; Fig. 3A).

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10. Regarding claim 8, Karas et al. teaches that the sender, website, and printing system communicate via the Internet which is inherently a network. (Fig. 1)

11. Regarding claim 17, Karas et al. teaches that the sender can go back and makes changes to the message. ([0053]).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Karas et al. (US 2002/0103711 A1).**

14. Regarding claim 3, Karas et al. teaches that if the sender previously registered with the website, the server would have the customer account information. ([0042]-[0043]) It is inherent that this is a "customer history database" that maintains information about the customers account information.

Karas et al. does not explicitly teach of maintaining history on previous purchases. However, OFFICIAL NOTICE is taken that it is common in the art to store data relating to the customers purchase data. It is done for numerous reasons. Some examples: so that the company can create internal reports, so that a user can see past purchases, etc. Therefore, it would have been obvious to one of ordinary skill in the art,

at the time of the invention, to have maintained a history of the customers' previous purchases. One would have been motivated to do so in order to create internal reports or allow users to see their past purchases.

15. Claims 5, 9, 10, 12-14, 19, 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Karas et al. (US 2002/0103711 A1) in view of Stoltz et al. (US 2002/0095576 A1).

16. Regarding claim 5, applicant further teaches that the motivation document is from a group comprising of a certificate of achievement, acknowledgement of service, or a team accomplishment certificate. Karas et al. teaches that the "gift gram" can be sent out for many occasions, including a birthday and graduation.

Karas et al. does not explicitly teach of a certificate of achievement, acknowledgement of service, or a team accomplishment. Stoltz. et al. teaches of a similar user recognition system. Stoltz et al.'s figures 8, 12 and 15 are examples of certificates that are the same as those listed by Applicant. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have used a certificate of achievement, acknowledgment of service, or a team accomplishment certificate. One would have been motivated to so in order to recognize the recipient for other accomplishments other than graduation, birthdays, etc.

17. Regarding claim 9, 12, 19, and 20, Karas et al. teaches that a sender (customer) selects a category (Fig. 2, 42); selects or enters a message (document) and an amount (award) to be sent to a recipient (participant). (Abstract). The sender chooses their

own message to be sent or selects from prewritten messages. (Fig 2). The message is customizable by the sender. (Fig. 3A; Fig. 9). The sender selects from various amounts to be sent to the recipient. (Fig. 2; [0039]). Optionally, the payment can be made to a specific merchant or store (ie. gift certificate), instead of to the recipient. ([0030]. Figure 2 is an example of the website (first program) to which the sender accesses and selects a custom message and amount that is to be transmitted to the recipient. (Fig. 1; Fig. 2; [0037]-[0039]). Figure 1 shows a printing system (second program) that renders the electronic version of the motivation message and amount (package) into an off-line format. (Fig. 1; Fig. 12; [0057]). The sender purchases the "gift-gram" by payment on the website. (Fig. 5, [0043]).

Karas et al. teaches that printing of the motivation message and amount are done at a printing system. ([0033]) Karas et al. does not explicitly teach of allowing the sender to print the motivation package at a location that they designate. Stoltz et al. teaches of a system for recognizing users through certificates whereby the sender can choose to print out the certificates or electronically transmit them to the recipient. ([0030], [0036]). Therefore, it would have been obvious to one of ordinary skill, at the time of the invention, to allow the sender to print out the message and award. One would have been motivated to do so in order to allow the sender flexibility in distributing the motivation message and award.

18. Regarding claim 10, Karas et al. teaches of printing at a printing system. ([0033]). Karas et al. does not explicitly teach of allowing the sender to print the package prior to a expiration date. Stoltz et al. teaches of a time period that is specified

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for the document and if the time period passes, the document is deactivated. ([0030]).

Therefore, it would have been obvious to one of ordinary skill, at the time of the invention, to have a set time period for the package to be printed. One would have been motivated to do so in order to prevent certificates and awards from being idle and unused.

19. Regarding claim 13, Karas et al. teaches of a first program for creating an electronic version of the message and award (Fig. 1; Fig. 2) and a second program for printing it (Fig. 1; [0057]).

20. Regarding claim 14, Karas et al. teaches that the sender, website, and printing system communicate via the Internet which is inherently a network. (Fig. 1).

21. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karas et al. (US 2002/0103711 A1) in view of Stoltz et al. (US 2002/0095576 A1) in view of Dubbels et al. (US 6,222,634 B1).

22. Regarding claims 7 and 15, Karas et al. teaches of printing the message and award. As stated above, Karas et al. does not explicitly teach where the documents are printed, however, Stoltz et al. teaches of a similar method of recognizing users whereby the sender ([0035]) or the receiver can print the certificate ([0035]-[0036]; [0040]). Stoltz et al. teaches that the sender or the receiver can print the certificate, download the certificate in electronic form, or email the certificate. ([0035]-[0043]).

Karas et al. does not explicitly teach of using a plug-in for a browser to print the certificates. As stated in the previous office action, plug-in's for rendering on screen or

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in browser documents are old and well-known. For example, Dubbels et al. teaches a method for printing web pages on the Internet. (Abstract) Dubbels et al. teaches of printing using a separate application, a plug-in, java applet, etc. (Col 7, Lines 1-15).

Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have used a plug-in to print the certificate. One would have been motivated to do so in order to print the certificate directly from the browser.

Conclusion

Examiner's Note: Examiner has cited particular columns, line numbers, and paragraphs in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing responses, fully consider each of the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art disclosed by the examiner.

Also, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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